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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,510	06/23/2003	Shinichi Sumida	038788.52520US	8644

23911 7590 02/25/2005  
CROWELL & MORING LLP  
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EXAMINER

KEYS, ROSALYND ANN

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/600,510

Applicant(s)

SUMIDA ET AL.

Examiner

Rosalynd Keys

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 15-22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-14 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/23/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-22 are pending.  
Claims 1-14 are allowed.  
Claims 15-22 are withdrawn from consideration.

### ***Election/Restrictions***

2. Applicant's election with traverse of Group I, claims 1-14, in the reply filed on December 6, 2004 is acknowledged. The traversal is on the ground(s) that Groups I-III are classified in the same class and subclass, thus a search for Group I would necessarily cover the same class and subclass as a search for Groups II and III. This is not found persuasive because although the Groups are classified in the same class the inventions are not disclosed as capable of use together and they have different modes of operation. Groups I-III have the same classification because they produce the same final product, i.e., the compound having the claimed formula (2). However, Groups I-III have different methods of producing the compound having the claimed formula (2). For example the method disclosed in Group I utilizes an acetylene compound (the compound having the claimed formula (3)) as a starting material, whereas the method of Group II utilizes an allyl compound (the compound having the claimed formula (12)) as a starting material and the method of Group III utilizes an aldehyde compound (the compound having the claimed formula (13)) as a starting material.

The requirement is still deemed proper and is therefore made FINAL.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

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***Information Disclosure Statement***

4. The information disclosure statement (IDS) submitted on June 23, 2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

***Allowable Subject Matter***

5. Claims 1-14 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter: Methods are known for making the compound having the claimed formula (2) or compounds which are structurally similar to the compounds having the claimed formula (2), see entire disclosure of US Patent No. 3,179,640 and column 4, lines 35-63 of US Patent No. 5,352,742. However, the prior art fails to teach or fairly suggest obtaining the compound having the claimed formula (2) by reacting the compounds having the claimed formulas (1) and (3).

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Middleton (US 3,179,640) teaches preparing compounds having the claimed formula (2) by pyrolysis of hydroxydi(polyfluoroalkyl)methyl-substituted ethyl benzenes (see entire disclosure).

Han et al. (US 5,352,742) teach preparing p-(1,1,1,3,3,3-hexafluoro-2-hydroxyisopropyl)- $\alpha$ -methylstyrene, a compound that is structurally similar to the compound having the claimed formula (2), see column 4, lines 35-63.

8. This application is in condition for allowance except for the following formal matters: the presence of claims 15-22 drawn to an invention non-elected with traverse in the reply filed on December 6, 2004.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

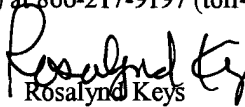
A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalyn Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M and F 3:00-8:00 pm and T-Th 5:30-10:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Rosalyn Keys  
Primary Examiner  
Art Unit 1621

February 20, 2005